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| 09/937,848 | 01/18/2002 | Carine Nizard | 24795 | 7105 |

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NATH & ASSOCIATES
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WASHINGTON, DC 20005

EXAMINER

WELLS, LAUREN Q

| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,848

Applicant(s)

NIZARD ET AL.

Examiner

Lauren Q Wells

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 94-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 94-113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 94-113 are pending. The amendment filed 3/23/04, cancelled claims 59-93 and added claims 94-113.

The cancellation of claims 59-93 in the amendment filed 3/23/04, is sufficient to overcome the claim objection and the 35 USC 112, 1st and 2nd paragraph, rejections in the previous Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 105 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 105 recites the limitation "the heated alcoholic solvent" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 94-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briand (English Translation of FR 2,657,012) in view of Winget (5,767,095).

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The instant invention is directed toward a method for promoting intercellular communication of skin cells, comprising the application, to the appropriate skin areas of a person in need thereof, of an effective amount of at least one lipid extract of the alga *Skeletonema*.

Briand teaches the use of microscopic algae extracts for the preparation of cosmetics, wherein the extracts have free radical reducing activity, wherein a decrease in free radical production is established in the art to reduce aging, see page 2. *Skeletonema* is specifically taught as a preferred extract, see page 3. The cosmetics are taught as compositions comprising algae extracts and additional cosmetic ingredients/agents for treating the skin, see page 12. External application is specifically taught, see page 12. Exemplified is a composition comprising 3% extract of *Skeletonema*. Briand does not teach the *Skeletonema* as a complete lipid extract, as water and an organic solvent art (ethanol and isopropanol) are taught as the extraction medium for *Skeletonema*.

Winget teaches anti-inflammatory compositions containing a purified microalgal lipid preparation for application to the skin. *Skeletonema* is specifically taught as a preferred algae. Such extracts are taught as imparting potent anti-inflammatory effects to the skin of a user. See Col. 1, line 19-Col. 2, line 55; Col. 10, lines 9-66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a lipid extract of *Skeletonema* into the compositions of Briand or to teach the extracts of Briand as lipid extracts, as taught by Winget, because of the expectation of achieving a product that treats existing skin aging and protects against further skin aging by UV damage (effect of antiinflammatories).

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It is respectfully pointed out that Briand et al. is directed toward reducing free radical activity, wherein a decrease in free radical production is established in the art to reduce aging, see page 2, and the instant invention is directed to treating aging by promoting intercellular communication of skin cells. Thus, Briand et al. is directed to a person in need thereof (someone with aging skin) and appropriate skin areas, i.e. areas that need reduction of free radical activity. Since Briand et al. teach the extract in the amount recited by the instant claims and specification, Briand et al. teach an effective amount of the alga *Skeletonema*.

The claims are directed to a method of applying a composition comprising a lipid extract of *Skeletonema* to appropriate skin areas of a person in need thereof. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently promote intercellular communication of skin cells, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Since a compound and its properties are inseparable, the *Skeletonema* of the combined references have the properties of promoting intercellular communication via gap junctions of

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keratinocytes, fibroblasts and skin preadipocytes and of promoting intercellular communication to promote the formation of connexin.

The Examiner respectfully points out instant claims 98-111 are product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Response to Arguments

Applicant argues, “none of the references, either alone or in combination, teach or suggest, a means for promoting interconnection of skin cells, or intercellular communication of skin cells, as is presently claimed. The references do not contain any suggestion or motivation that they be combined in the manner suggested in the Office Action”. This argument is not persuasive. While Applicant has made the above statement, Applicant has provided no rationale for the lack of motivation or reasons why the rejection does not teach the limitations. For the reasons stated above, the instant rejection teaches all of the limitations of the instant claims and provides motivation to combine the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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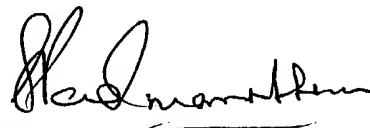
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER